

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re: Application of:	:
Suzann Marie Keohane	:
	: Before the Examiner:
Serial No: 10/666,816	: Thomas J. Dailey
	:
Filed: 09/18/2003	: Group Art Unit: 2152
	:
Title: SYSTEM, APPARATUS AND	: Confirmation No.: 8940
METHOD OF RESCINDING	:
PREVIOUSLY TRANSMITTED E-	:
MAIL MESSAGES	:

**RESPONSE TO OFFICE ACTION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Office Action of April 30, 2007, please amend the above-identified Application as shown below and consider the following Remarks.

**CHANGES to the SPECIFICATION** begin on page 2 of this paper

**A LIST OF THE PENDING CLAIMS** begins on page 4 of this paper.

**Remarks** begin on page 16 of this paper.

AUS920030442US1

IN THE SPECIFICATION:

Please replace the paragraph on page 13, line 23 to page 14, line 15 with the following paragraph:

Fig. 4b is a GUI in which the message may be presented to the sender. Except for RESCIND button 450, the GUI is identical to the one in Fig. 4a. When RESCIND button 450 is asserted, the GUI in Fig. 6 may be displayed. Fig. 6 depicts a representative GUI that may be used to rescind or preclude recipients from accessing a message. The e-mail addresses of all the recipients to whom the message was addressed are listed in the figure. Thus, the sender may choose which one(s) of the recipients who are not to access the message. To do so, the sender may enter a checkmark in box 604 next to the e-mail addresses of the recipients to be precluded from accessing the message. If the recipient sender enters a checkmark in box 602, a check mark will automatically be entered in all boxes 604. In this case, the e-mail message will be rescinded. When the sender is satisfied, the sender may assert OK button 606. Upon asserting OK button 606, Fig. 4b may be re-displayed. In this case, the e-mail address of any recipient who has been excluded will not be displayed in any of boxes 400, 405 and 410. As customary, if the sender reconsiders, the sender may assert CANCEL button 608. In any case, when a recipient who has been precluded from accessing the message attempts to retrieve the message, an error message such as "SORRY MESSAGE HAS BEEN RESCINDED" may be returned to the recipient.

Please replace the paragraph on page 16, lines 24 – 32 with the following paragraph:

If the message is a modified message, the server may consult the cross-referencing table in Fig. 7 to determine which private key to use to encrypt the AUS920030442US1

message. As mentioned earlier, the private key used has to be the same as the one used to encrypt the original message. After encrypting the modified message, the sender may replace the original (or previous) message in storage with the modified message before the process ends (steps 800, 802, 814 816 and 812).

Please replace the paragraph on page 17, lines 1 – 12 with the following paragraph:

Fig. 9 is a flowchart of a process that may be used by a server servicing a sender when an e-mail message is being accessed. The ~~sender~~ server will compare the e-mail address of the person attempting to access the e-mail message with the email addresses of the recipients and the sender of the message. If the person attempting to access the e-mail message has the same e-mail address as the sender or anyone of the recipients of the e-mail message, the person will be allowed to access the e-mail message. Otherwise, an error message such as MESSAGE HAS BEEN RESCINDED may be generated before the process ends (steps 900, 902, 904, 906, 908, 910, 912 and 914).

IN THE CLAIMS:

This listing of claims will replace all prior versions, and listing of claims, in the Application.

Listing of claims:

1. (Currently amended) A method of rescinding previously transmitted e-mail messages by a sender, the ~~message~~ messages being addressed to a list of recipients, the method comprising the steps of:

storing ~~the~~ an e-mail message addressed to a list of recipients on a computing system;

generating a notification message, the notification message for allowing ~~the recipients from the list of recipients~~ and the sender to ~~automatically~~ access the stored e-mail message;

sending the notification message to the recipients from the list of recipients and to the sender; and

enabling the sender, using the notification message, to preclude one of the recipients from the list of recipients from accessing the stored e-mail message

~~excluding recipients from the list of recipients whereby only recipients who remain in the list of recipients may access the e-mail message.~~

2. Canceled.

3. (Currently amended) The method of Claim [[2]] 1 wherein the e-mail message has a text portion, the sender being allowed to modify the text portion.
4. (Currently amended) The method of Claim 3 wherein the stored e-mail message may be encrypted by a private key of a private key/public key pair, the public key being in the notification message for automatically decrypting the stored e-mail message.
5. (Currently amended) The method of Claim 4 wherein the computing system is the computing system on which the stored e-mail message was composed.
6. (Original) The method of Claim 4 wherein the computing system is a server, the server generating and sending the notification message to the recipients and sender.
7. (Currently amended) A method of modifying a previously transmitted e-mail message by a sender, the message being addressed to a list of recipients, the method comprising the steps of:

storing the e-mail message on a computing system;

generating a notification message, the notification message for allowing the recipients from the list of recipients and the sender to automatically access the stored e-mail message;

sending the notification message to the recipients from the list of recipients and to the sender; and

enabling the sender to modify the stored e-mail message using the notification message wherein the enabling step includes:

determining whether at least one recipient from the list of recipients has already accessed the stored e-mail message;

displaying the list of recipients and a copy of the stored e-mail message to the user wherein all recipients from the list of recipients that are determined to have already accessed the stored e-mail message are displayed in a distinguishing fashion from recipients that have not already accessed the stored e-mail message;

allowing the sender to modify the displayed copy of the stored e-mail message and to send the modified copy to the recipients that have not already accessed the stored e-mail message; and

replacing the stored e-mail message with the modified copy once the modified copy is sent to the recipients that have not already accessed the stored e-mail message.

8. (Currently amended) The method of Claim 7 wherein the stored e-mail message has a text portion, the text portion being modified by the sender.
9. (Currently amended) The method of Claim 7 wherein the e-mail message has a list of recipients ~~is, the list of recipients being~~ modified by the sender by adding new recipients to the list or deleting recipients from the list.
10. (Currently amended) The method of Claim 7 wherein the stored e-mail message may be encrypted by a private key of a private key/public key

pair, the public key being in the notification message for automatically decrypting the stored e-mail message.

11. (Currently amended) A computer program product on a computer readable medium for rescinding previously transmitted e-mail messages by a sender, the message messages being addressed to a list of recipients, the computer program product comprising:

code means for storing the an e-mail message addressed to recipients in a list of recipients on a computing system;

code means for generating a notification message, the notification message for allowing the recipients from the list of recipients and the sender to ~~automatically~~ access the stored e-mail message;

code means for sending the notification message to the recipients in the list of recipients and to the sender; and

code means for enabling the sender, using the notification message, to preclude one of the recipients in the list of recipients from accessing the stored e-mail message

~~code means for excluding recipients from the list of recipients whereby only recipients who remain in the list of recipients may access the e-mail message.~~

12. Canceled.

13. (Currently amended) The computer program product of Claim 12 11 wherein the e-mail message has a text portion, the sender being allowed to modify the text portion.
14. (Currently amended) The computer program product of Claim 13 wherein the stored e-mail message may be encrypted by a private key of a private key/public key pair, the public key being in the notification message for automatically decrypting the stored e-mail message.
15. (Currently amended) The computer program product of Claim 14 wherein the computing system is the computing system on which the stored e-mail message was composed.
16. (Original) The computer program product of Claim 14 wherein the computing system is a server, the server generating and sending the notification message to the recipients and sender.
17. (Currently amended) A computer program product on a computer readable medium for modifying a previously transmitted e-mail message by a sender, the message being addressed to a list of recipients, the computer program product comprising:

code means for storing the e-mail message on a computing system;

code means for generating a notification message, the notification message for allowing recipients from the list of the recipients and the sender to automatically access the stored e-mail message;

code means for sending the notification message to the recipients in the list of recipients and to the sender; and



code means for enabling the sender to modify the stored e-mail message  
using the notification message wherein the enabling code means includes:

code means for determining whether at least one recipient from the  
list of recipients has already accessed the stored e-mail message;

code means for displaying the list of recipients and a copy of the  
stored e-mail message wherein all recipients from the list of  
recipients that are determined to have already accessed the stored  
e-mail message are displayed in a distinguishing fashion from  
recipients that have not already accessed the stored e-mail  
message;

code means for allowing the sender to modify the displayed copy of  
the stored e-mail message and to send the modified copy to the  
recipients that have not already accessed the stored e-mail  
message; and

code means for replacing the stored e-mail message with the  
modified copy once the modified copy is sent to the recipients that  
have not already accessed the stored e-mail message.

18. (Currently amended) The computer program product of Claim 17 wherein the stored e-mail message has a text portion, the text portion being modified by the sender.
19. (Currently amended) The computer program product of Claim 17 wherein the ~~e-mail message has a list of recipients is,~~ the list of recipients being

modified by the sender by adding new recipients to the list or deleting recipients from the list.

20. (Currently amended) The computer program product of Claim 17 wherein the stored e-mail message may be encrypted by a private key of a private key/public key pair, the public key being in the notification message for automatically decrypting the stored e-mail message.
21. (Currently amended) An apparatus for rescinding previously transmitted e-mail messages by a sender, the message messages being addressed to a list of recipients, the apparatus comprising:

means for storing ~~the~~ an e-mail message addressed to recipients in a list of recipients on a computing system;

means for generating a notification message, ~~the~~ notification message for allowing the recipients from the list of recipients and the sender to ~~automatically~~ access the stored e-mail message;

means for sending the notification message to the recipients in the list of recipients and to the sender; and

means for enabling the sender, using the notification message, to preclude one of the recipients from the list of recipients from accessing the stored e-mail message

~~means for excluding recipients from the list of recipients whereby only recipients who remain in the list of recipients may access the e-mail message.~~

22. Canceled.
23. (Currently amended) The apparatus of Claim [[22]] 21 wherein the message has a text portion, the sender being allowed to modify the text portion.
24. (Currently amended) The apparatus of Claim 23 wherein the stored e-mail message may be encrypted by a private key of a private key/public key pair, the public key being in the notification message for automatically decrypting the stored e-mail message.
25. (Currently amended) The apparatus of Claim 24 wherein the computing system is the computing system on which the stored e-mail message was composed.
26. (Original) The apparatus of Claim 24 wherein the computing system is a server, the server generating and sending the notification message to the recipients and sender.
27. (Currently amended) An apparatus for modifying a previously transmitted e-mail message by a sender, the message being addressed to recipients in a list of recipients, the apparatus comprising:

means for storing the e-mail message on a computing system;

means for generating a notification message, the notification message for allowing the recipients from the list of recipients and the sender to ~~automatically~~ access the stored e-mail message;

means for sending the notification message to the recipients from the list of recipients ~~and to the sender~~; and

means for enabling the sender to modify the stored e-mail message using the notification wherein the enabling means includes:

means for determining whether at least one recipient from the list of recipients has already accessed the stored e-mail message;

means for displaying the list of recipients and a copy of the stored e-mail message wherein all recipients from the list of recipients that are determined to have already accessed the stored e-mail message are displayed in a distinguishing fashion from recipients that have not already accessed the stored e-mail message;

means for allowing the sender to modify the displayed copy of the stored e-mail message and to send the modified copy to the recipients that have not already accessed the stored e-mail message; and

means for replacing the stored e-mail message with the modified copy once the modified copy is sent to the recipients that have not already accessed the stored e-mail message.

28. (Currently amended) The apparatus of Claim 27 wherein the stored e-mail message has a text portion, the text portion being modified by the sender.
29. (Currently amended) The apparatus of Claim 27 wherein the ~~e-mail message~~ has a list of recipients ~~is, the list of recipients being~~ modified by

the sender by adding new recipients to the list or deleting recipients from the list.

30. (Currently amended) The apparatus of Claim 27 wherein the stored e-mail message may be encrypted by a private key of a private key/public key pair, the public key being in the notification message for automatically decrypting the stored e-mail message.
31. (Currently amended) A system for rescinding previously transmitted e-mail messages by a sender, the ~~message~~ messages being addressed to a list of recipients, the system for comprising:

at least one storage device for storing code data; and

at least one processor for processing the code data to store ~~the~~ an e-mail message addressed to recipients in a list of recipients thereon, to generate a notification message, the notification message for allowing the recipients from the list of recipients and the sender to automatically access the stored e-mail message, to send the notification message to the recipients in the list of recipients and to the sender, and to enable the sender, using the notification message, to preclude one recipient from the list of recipients from accessing the stored e-mail message ~~exclude recipients from the list of recipients whereby only recipients who remain in the list of recipients may access the e-mail message.~~

32. Canceled.
33. (Currently amended) The system of Claim ~~[[32]]~~ 31 wherein the stored e-mail message has a text portion, the sender being allowed to modify the text portion.

AUS920030442US1

34. (Currently amended) The system of Claim 33 wherein the stored e-mail message may be encrypted by a private key of a private key/public key pair, the public key being in the notification message for automatically decrypting the stored e-mail message.
35. (Original) The system of Claim 34 wherein the computing system is the computing system on which the stored e-mail message was composed.
36. (Original) The system of Claim 34 wherein the computing system is a server, the server generating and sending the notification message to the recipients and sender.
37. (Currently amended) A system for allowing a previously transmitted e-mail message by a sender to be modified, the message being addressed to a list of recipients, the system comprising:

at least one storage device for storing code data; and

at least one processor for processing the code data to store the e-mail message thereon, to generate a notification message, the notification message for allowing the recipients from the list of recipients and the sender to automatically access the stored e-mail message, to send the notification message to the recipients from the list of recipients and to the sender, and to enable the sender to modify the stored e-mail message using the notification message wherein the code data is further processed to determine whether at least one recipient has already accessed the stored e-mail message, to display the list of recipients and a copy of the stored e-mail message wherein all recipients that are determined to have already accessed the stored e-mail message are displayed in a

distinguishing fashion from recipients that have not already accessed the stored e-mail message, to allow the sender to modify the displayed copy of the stored e-mail message and to send the modified copy to the recipients that have not already accessed the stored e-mail message, and to replace the stored e-mail message with the modified copy once the modified copy is sent to the recipients that have not already accessed the stored e-mail message.

38. (Currently amended) The system of Claim 37 wherein the stored e-mail message has a text portion, the text portion being modified by the sender.
39. (Currently amended) The system of Claim 37 wherein the ~~e-mail message~~ has a list of recipients ~~is, the list of recipients being~~ modified by the sender by adding new recipients to the list or deleting recipients from the list.
40. (Currently amended) The system of Claim 37 wherein the stored e-mail message may be encrypted by a private key of a private key/public key pair, the public key being in the notification message for automatically decrypting the stored e-mail message.

**REMARKS**

In the above-identified Office Action, the Examiner rejected Claims 1 - 6, 9 - 16, 19 - 26, 29 - 36, 39 and 40 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Claims 1 - 3, 7 - 9, 11 - 13, 17 - 19, 21 - 23, 27 - 29, 31 - 33 and 37 - 39 were rejected under 35 U.S.C. §102(b) as being anticipated by Brogné et al. Claims 4 - 6, 10, 14 - 16, 20, 24 - 26, 30, 34 - 36 and 40 were rejected under 35 U.S.C. §103(a) as being unpatentable over Brogné et al. in view of what is known in the art.

In response to the 112 rejection of the claims, Applicants have amended independent Claims 1, 7, 11, 17, 21, 27, 31 and 37 to distinctly claim the invention. Particularly, in independent Claims 1, 11, 21 and 31, the claimed invention has been changed to include that "the e-mail message is sent to a plurality of recipients," that "the notification message is also sent to the sender to allow the sender to access the stored e-mail message" and that by accessing the stored e-mail message the sender can preclude some of the recipients from accessing the message." Support for these changes can be found on page 13, line 14 to page 14, line 15.

Independent Claims 7, 17, 27 and 37 are changed to include that "the e-mail message is sent to a plurality of recipients," "the notification message is also sent to the sender" and that the sender can access the stored e-mail message to modify it." In this case, (1) a copy of the message is displayed to the sender, (2) the plurality of the recipients to whom the message is sent is also displayed to the sender with all the recipients that have already accessed the stored e-mail message being displayed in a distinguishing fashion and (3) the sender can modify the stored e-mail message by making changes to the displayed copy of the message and sending the modified copy to the recipients who have not yet accessed the stored e-mail message. Once sent, the modified copy of the



message replaces the stored e-mail message. Support for these changes can be found on page 13, lines 14 – 22, and page 14, line 16 to page 15, line 3.

Consequently, no new matter has been added to the SPECIFICATION by the changes made to the claims. Applicants believe that the 112 rejection has been overcome and kindly request its withdrawal.

Due to the changes made to independent Claims 1, 11, 21 and 31 and in view of the applied reference, Applicants have canceled Claims 2, 12, 22 and 32. Hence, Claims 3, 13, 23 and 33 which depended on Claims 2, 12, 22 and 32 have been amended to change their dependency from a canceled claim to a non-canceled claim. Claims 4, 5, 8 - 10, 14, 15, 18 - 20, 24, 25, 28 – 30, 34, 35 and 38 - 40 were also amended to better claim the invention.

By this amendment, Claims 1, 3 – 11, 13 – 21, 23 – 31 and 33 - 40 remain pending in the Application. For the reasons stated more fully below, Applicants submit that the pending claims are allowable over the applied reference. Hence, reconsideration, allowance and passage to issue are respectfully requested.

As stated in the SPECIFICATION, sometimes, a sender of an e-mail message may realize that a recipient should not have been sent the message or that the message has some typographical and/or grammatical errors etc. that should be corrected before it is read by the recipients. In those cases, the sender may want to preclude the recipient from retrieving the e-mail message or correct the errors in the message before it is read by the recipients. Unfortunately, once an e-mail message has been transmitted it may not be withdrawn or modified. Thus, a need exists for a method of precluding a recipient from retrieving a message or allowing a message to be corrected after it has been transmitted. The present invention provides such a method.

According to the teachings of the invention, when a message is sent to recipients, the message is stored on a computer system. The computer system generates a notification message which is sent to the recipients as well as to the sender. Using the notification message, the sender may access the stored

message to preclude any recipients that the sender decides should not read the e-mail message from reading the message or to modify the message.

In certain cases, the sender may want to know which one(s) of the recipients has or have already read the message before modifying the message. In those cases, when the sender accesses the stored message, a copy of the message will be displayed to the sender along with a list of the recipients to whom the message was sent. All the recipients from the list that have already accessed the message will be displayed in a distinguishing manner.

The invention is set forth in claims of varying scopes of which Claims 1 and 7 are illustrative.

1. A method of rescinding previously transmitted e-mail messages by a sender, the messages being addressed to a list of recipients, the method comprising the steps of:

storing an e-mail message addressed to a list of recipients on a computing system;

generating a notification message, the notification message for allowing recipients from the list of recipients and the sender to access the stored e-mail message;

sending the notification message to the recipients from the list of recipients and to the sender; and

***enabling the sender, using the notification message, to preclude one of the recipients from the list of recipients from accessing the stored e-mail message.*** (Emphasis added.)

7. A method of modifying a previously transmitted e-mail message by a sender, the message being addressed to a list of recipients, the method comprising the steps of:

storing the e-mail message on a computing system;

generating a notification message, the notification message for allowing recipients from the list of recipients and the sender to access the stored e-mail message;

sending the notification message to the recipients from the list of recipients and to the sender; and

***enabling the sender to modify the stored e-mail message using the notification wherein the enabling step includes:***

***determining whether at least one recipient from the list of recipients has already accessed the stored e-mail message;***

***displaying the list of recipients and a copy of the stored e-mail message to the user wherein all recipients from the list of recipients that are determined to have already accessed the stored e-mail message are displayed in a distinguishing fashion from recipients that have not already accessed the stored e-mail message;***

***allowing the sender to modify the displayed copy of the stored e-mail message and to send the modified copy to the recipients that have not already accessed the stored e-mail message; and***

***replacing the stored e-mail message with the modified copy once the modified copy is sent to the recipients that have not already accessed the stored e-mail message.*** (Emphasis added.)

The Examiner rejected the independent claims under 35 U.S.C. §102(b) as being anticipated by Brogné et al. Applicants submit that the claims, as presently drafted, are patentable over Brogné et al.

Brogné et al. purport to teach a method of manipulating an already sent e-mail message. According to the teachings of Brogné et al., a sender of an e-mail message may retract or modify the e-mail message so long as the e-mail message has not yet been accessed by an addressee. To allow the sender to retract or modify the e-mail message, the e-mail message is sent to a server, where the body of the message is stored together with an access code. The server then sends a notification of the e-mail message to the addressees. The notification includes the access code. The server keeps tab on whether the e-mail message has been accessed. When the server receives a modification message dedicated to modify the stored e-mail message, the server will allow the

AUS920030442US1

stored e-mail message to be modified if and only if the e-mail body of the message has not yet been accessed by any one of the addressees.

However, Brogné et al. do not teach, show or suggest that addressees of the e-mail message can be precluded from reading the message. Therefore, Brogné et al. do not teach the step of ***enabling the sender, using the notification message, to preclude one of the recipients from the list of recipients from accessing the stored e-mail message*** as claimed in Claim 1.


Further, Brogné et al. specifically teach that a sender of an e-mail message may retract or modify the e-mail message so long as the e-mail message has not yet been accessed by an addressee (see col. 2, line 6, col. 2, lines 21 – 25, col. 5, line 56 to col. 6, line 14 and col. 8, lines 35 - 51). Consequently, Brogné et al. do not teach, show or suggest the steps of ***enabling the sender to modify the stored e-mail message using the notification message wherein the enabling step includes: determining whether at least one recipient from the list of recipients has already accessed the stored e-mail message; displaying the list of recipients and a copy of the stored e-mail message to the user wherein all recipients from the list of recipients that are determined to have already accessed the stored e-mail message are displayed in a distinguishing fashion from recipients that have not already accessed the stored e-mail message; allowing the sender to modify the displayed copy of the stored e-mail message and to send the modified copy to the recipients that have not already accessed the stored e-mail message; and replacing the stored e-mail message with the modified copy once the modified copy is sent to the recipients that have not already accessed the stored e-mail message*** as claimed in Claim 7.

Since Brogné et al. do not teach the emboldened/italicized limitations in the above-reproduced Claims 1 and 7, Applicants submit that Claims 1 and 7, along with their dependent claims, are allowable over the teachings of Brogné et al. The other independent claims (i.e., Claims 11, 21 and 31), which all include the emboldened/italicized limitations of the above-reproduced Claim 1 and  
AUS920030442US1

Appl. No. 10/666,816  
Response to Office Action dated 07/30/2007  
Reply to Office Action of 04/30/2007

independent Claims 17, 27 and 37, which include the emboldened/italicized limitations of the above-reproduced Claim 7 as well as their dependent claims, are also allowable over the teachings of Brogné et al. Consequently, Applicants once more respectfully request reconsideration, allowance and passage to issue of the claims in the application.

Respectfully Submitted

By:   
Volet Emile  
Attorney for Applicants  
Registration No. 39,969  
(512) 306-7969